

REMARKS

Reconsideration of the above identified application is respectfully requested.

On 05/03/2007, a paper entitled "Defective Office Action" was filed to traverse the examiner's failure to duly consider properly submitted reference DE 1061134.

On 05/18/2007, the undersigned attorney left a phone message with the examiner to determine the status of action therefor, and on 05/21/2007, the examiner returned the phone call to state that a supplemental office action was being mailed to confirm due consideration of the DE 1061134 reference.

In the present office action, page 1, Box 5 is unmarked, and Box 7, has been checked to indicate that "Claim(s) 1-10, 14-24 is/are objected to."

However, page 4 of the office action indicates that "Claims 1-10 are allowed," whereas only claims 14-24 stand objected to.

Correction of this additional defect in the office action is also requested.

Claim 23 has been amended to conform the preamble to its parent claim 1b.

Applicants traverse the rejection of claim 25 under 35 USC 101 and 112, second paragraph.

The examiner has misinterpreted method claim 25; has failed to duly apply Sections 101 & 112; and has failed to fully consider applicable MPEP provisions, including 821.04(b) in addition to 2173.05(p)(II) cited by the examiner.

Firstly, the U.S. Supreme Court has clearly held that anything made by man under the sun is patentable, and to the extent the MPEP is inconsistent therewith, then the MPEP is in error.

As for the MPEP distinctions between "process" and

"machine" under 2173.05(p)(II), the examiner has failed to show how the facts in that provision are relevant to Applicants' method claim 25, when they are not.

Method claim 25 was expressly written under the guidelines of MPEP 821.04(b) and recites the method of operating the apparatus recited in claim 23.

This provision of the MPEP permits the Applicants to submit method claim 25 as a "matter of right," and preferably in dependent form, as indeed originally presented.

Accordingly, the examiner has failed to establish any basis to reject method claim 25 under Sections 101 or 112, or over the art of record; and since this claim complies with MPEP 821.04(b), then the rejection thereof must be withdrawn, which is hereby requested.

Applicants traverse the rejection of claims 11 and 12 under Section 102(b) and (e) over Engl and Prince.

Applicants note the substantial breadth of interpretation of Applicants' claims being proffered by the examiner, which correspondingly enlarges claim scope in later infringement analysis of the file wrapper. However, the examiner has failed to afford due weight to specific features and cooperation of features which distinguish over the applied art.

The primary basis used by the examiner in rejecting these claims is the stated failure to afford any weight to the claim preamble as being "a mere statement of intended use."

However, independent claims 11 does not contain such a preamble of mere intended use, but, to the contrary, expressly recites an apparatus as being a "gas turbine engine afterburner."

Claim 11 does not merely recite an apparatus for "use in a gas turbine engine."

And, the examiner has failed to consider the applicable law in this regard as found in MPEP 2111.02, including the

Kropa case cited therein.

In Kropa, "an abrasive article" was recited in the preamble and was found to give life and meaning to the claim and essential to its interpretation.

Similarly, Applicants' claim 11 expressly recites "a gas turbine engine afterburner," which has no similarity to the rocket motors disclosed in Engl and Prince.

The construction is different, the sizes are different, and the mode of operation is quite different.

It would therefore be physically impossible to "use" the rocket motor nozzles in Engl and Prince in a gas turbine engine afterburner because of the fundamental differences in operating environments, and the examiner has not shown otherwise.

The examiner has intentionally chosen to broadly interpret Applicants' claims and the applied references, and disregard the express claim language in typical examination practice before the PT0.

The examiner has evaluated only the general similarities between the recited elements and the applied rocket motors, without due regard to the fundamental differences therebetween, which includes the express preamble recitation of the gas turbine engine afterburner itself.

A "mouse" and an "elephant" both have a body, head, and four legs; but would they anticipate each other in corresponding claims for "An animal?"

How about in claims to "A mouse comprising," or "An elephant comprising?"

Are those preambles mere statements of intended (mouse or elephant) use, or do those preambles give life and meaning to those claims?

So, what weight should the examiner afford to the recited "gas turbine engine afterburner."

Since the examiner has taken a broad view of the recited preamble, claim 11 is nevertheless being amended to

recite in the body thereof the "gas turbine engine exhaust duct" feature to overcome the preamble rejection; and the preamble is being amended to additionally recite features of the gas turbine engine which cooperate with the features recited in the body.

The recited afterburner has an inlet at one end and the nested nozzles at the other end.

The inlet end is configured to join the engine to receive the exhaust flow therefrom. And the nozzles are configured to discharge that exhaust flow.

Claims 23 & 25 expressly recite cooperation of the afterburner with the upstream engine. And, paras. 26, 31, 44, and 53 disclose these exemplary features.

Para. 61 et seq disclose how the afterburner configuration affects engine performance, including stall margin, having no counterpart in the disparate rocket motors being applied by the examiner.

"Intended use" is indeed quite important, primarily because the applied rocket motors are not intended, nor configured, for use in a gas turbine engine, and the examiner's statement of mere "presumed capability" is without relevancy or merit since the examiner has expressly failed to afford any weight to the preamble recitation of the gas turbine engine afterburner, which is quite specific and not "a general type" as the examiner incorrectly opines.

The cited MPEP provision on preambles, and associated case law, should now permit the examiner to evaluate claim 11 for the specific apparatus it is: a gas turbine engine afterburner; and not a rocket motor.

The differences in configuration are therefore substantial and significant, and are entitled to due weight.

The afterburner must be configured to operate with the engine which discharges hot combustion gases thereto; whereas the rocket motor must be configured to operate alone without any upstream engine, but, instead, with upstream rocket fuel.

The examiner must disregard these fundamental facts when stating superficially that "the corresponding prior art exhaust nozzle structure must be presumed equally capable" of use in a gas turbine afterburner.

It would be impossible to use the rocket nozzles in the applied references in an afterburner, since the examiner has overlooked the solid rocket fuel also contained in those rocket motors.

Is a "mouse" an "elephant," and is a "gas turbine engine afterburner" the same as the "general type" rocket motor?

Accordingly, withdrawal of the rejection of claims 11 and 12 under Section 102(b) and (e) over Engl and Prince is warranted and is requested.

Applicants traverse the rejection of claim 13 under Section 102(b) over Engl.

Claim 13 depends from claims 12 and 11, and expressly recites a gas turbine engine afterburner, and is not related to the rocket motor of Engl, combustible material or not.

Indeed, Engl also discloses the upstream fuel body 2 essential to its operation, but which would clearly render inoperative for its intended purpose any afterburner for a gas turbine engine.

For the same reasons presented above, the examiner has failed to afford due weight to claim 13, and has failed to establish any anticipation as required under Section 102.

Nevertheless, claim 13 now depends from amended claim 11, and further distinguishes over the disparate rocket motor of Engl.

Accordingly, withdrawal of the rejection of claim 13 under Section 102(b) over Engl is warranted and is requested.

Applicants note the allowance of original claims 1-10, which are entitled to broad scope in view of the examiner's broad interpretation of the claims and references.

Applicants also note the allowability of claims 14-24.

Claim 14 has therefore been amended to independent form to include features from its original parent claims 11 and 12; and should now be in condition for allowance, and entitled to the commensurate broad interpretation proffered by the examiner.

This applies also to claims 15-24, and method claim 25 which all depend from claim 14.

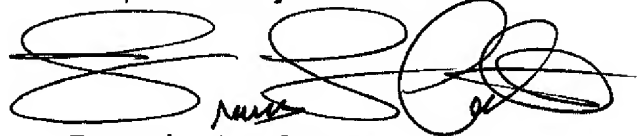
In accordance with the duty imposed by 37 CFR 1.104 and MPEP sections 707, 707.05, 707.07, and 707.07(g), the examiner is requested to reconsider all the art of record, including the additional references not applied, to ensure full compliance with the required thoroughness of examination.

In re Portola Packaging, Inc., 42 USPQ2d 1295 (Fed. Cir. 1997) emphasizes the importance of complying with this duty to ensure that all references of record have been fully considered by the examiner in the various combinations thereof. And, the Board of Appeals has further elaborated on the importance of this examiner duty in Ex parte Schricker, 56 USPQ2d 1723 (B.P.A.I. 2000).

Please note that a drawing amendment is being concurrently filed with this amendment.

In view of the above remarks, allowance of all claims 1-25 over the art of record is warranted and is requested.

Respectfully submitted,

A handwritten signature in dark ink, appearing to read 'Francis L. Conte', is written over a series of horizontal lines.

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